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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/171,928 10/05/98 INOMATA

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EXAMINER

BORIN, M

ART UNIT

PAPER NUMBER

1654
DATE MAILED:

12/09/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 928 Application(s)

09/171,288

Inomata et al.

Examiner

M. Borin

Group Art Unit

1654

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-20 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Part III DETAILED ACTION

Claims 1- 20 are currently pending.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1-6, 15-19 drawn to pharmaceutical composition.
- II. Claims 7-14, drawn to method of use of the pharmaceutical composition of Group I.
- III. Claim 12, drawn to method of making.

The inventions listed as Groups do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I is the technical feature that links Groups I to III. Group I is not the contribution over the prior art because it is suggested by references teaching pharmaceutical compositions of agents effecting natriuretic peptide receptor. For example, compositions comprising natriuretic peptide are taught or suggested in the references A-E listed in

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the International Search Report, or further disclosed, e.g., in US 5,356,925 or US 5,352,587. Therefore, the lack of unity is present because the linking technical feature is not a "special technical feature" as defined by PCT Rule 13.2.

Inventions I and II are related as product and process of use. In the instant case the method of use can be practiced with a broad variety of drugs beyond the claimed compositions, e.g., with compositions comprising 2-oxo-imidazolidine compounds. Further, the product as claimed can be used in a materially different processes such as treatment of respiratory distress syndrome.

Inventions III and I are related as process of making and product made. In the instant case process as claimed can be used to make other and materially different products.

Because these inventions are distinct for the reasons given and have acquired a separate status in the art because of their recognized divergent subject matter, and the necessity for non-coextensive literature searches, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can

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normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, the examiner's supervisor, Mr. Michael Woodward, can be reached on (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

December 1, 1999

mlb



MICHAEL BORIN, PH.D.
PATENT EXAMINER